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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,849	11/07/2000	Alan S. Fisher	2043.086US2	8858
49845	7590	03/01/2010		
SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 03/01/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM
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Office Action Summary

Application No.

09/706,849

Applicant(s)

FISHER ET AL.

Examiner

OLABODE AKINTOLA

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 24-30, 32-39, 41-48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22, 24-30, 32-39, 41-48 and 50-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 18-22, 24-30, 32-39, 41-48 and 50-52 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-22, 24-30, 32-39, 41-48 and 50-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitation “a bid validation... for ensuring that the *bid amount is credible in view of a current high bid*”. There is no support for this limitation in the originally filed disclosure. Applicant is requested to cite portion(s) of the originally filed disclosure that provides support for this limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22, 24-25, 44-48 and 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per Claims 18-22 and 24-25, Applicant asserts that the claim elements “means for” are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, it is unclear whether the claim elements are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. If applicant wishes to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

Examiner notes that the one or more processors are a sufficient structure, material or act that modify the “means for” language.

Per Claims 44-48 and 50-52, the scope of the system claim is not clear. In particular, it is not clear whether the auction manager is a software, hardware or a combination of both. Appropriate correction is requested.

For examination purpose, Examiner treats the auction manager as a processor configured to execute instructions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19, 22, 24, 26-27, 30, 33, 35-36, 39, 41-42, 44-45, 48, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (USPN 5845265) ("Woolston") in view of Fraser et al (US 5329589) ("Fraser") and further in view of Philips et al (USPN 5047959) ("Philips").

Re claims 18, 26, 35 and 44: Woolston teaches computer system for conducting an auction through a computer network, the system comprising: a posting means for posting to a computerized merchandise catalog information that is accessible through the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item (col. 3, lines 8-67, col. 4, lines 10-27, col. 5, lines 48-55), the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is substantially continuously updated in the merchandise catalog as items in each lot are made available for auction (col. 7, lines 16-30); a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots (col. 6, lines 21-29); a bid validation

means for examining the bid (col. 6, lines 37-44); and a bid categorizing means for determining whether the bid is successful or unsuccessful (col. 6, lines 30-33, col. 10, lines 33-63), and a bid database for storing the bid (col. 6, lines 21-44), wherein the posting means, bid receiving means, bid validation means and bid database are implemented with one or more processors configured to execute instructions stored in memory (figure 1).

Woolston does not explicitly teach a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction and for ensuring that the bid amount is credible in view of a current high bid, the characteristic of the bid being a form of bid information, and the validating of the characteristic includes ensuring that the bid information accords with a specific form of the bid information that is defined by a bid format.

Fraser teaches a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, the characteristic of the bid being a form of bid information (col. 14, lines 16-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to valid a characteristic of bid as taught by Fraser. One would have been motivated to do so in order to ensure that the bid information is valid.

Philips, using the same problem solving technique, teaches the concept of examining the characteristics of data entered by a user to validate the data for ensuring that the data values (*bid amount*) are credible in view of a valid data criterion (*current high bid*), and the validating of the characteristic includes ensuring that the data values accords with a specific form of the data value that is defined by a data type or set or range of legal values (*bid format*) (col. 6, lines 40-58, col. 7, lines 38-43). Therefore, it would have been obvious to one of ordinary skill in the art

at the time of the invention to modify Woolston and Fraser combination to include this feature as taught by Philips. One would have been motivated to do so in order to insure that the values entered by the user are valid, thereby preserving the integrity of process/system.

Re claims 19, 27, 36 and 45: Woolston teaches an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats (col. 5, line 50)

Re claims 22, 30, 39 and 48: Woolston teaches wherein the posting means is adapted to receive a message posted through the computer network corresponding to a lot and to post the message in association with the descriptive information for that lot (Figure 13).

Re claims 24, 32, 33, 41, 42, 50 and 51: Woolston teaches wherein the bid receiving means is for receiving bids on at least two lots that are simultaneously open for auction, the at least two lots having different associated auction formats, and wherein the bid categorizing the means is for automatically categorizing the received bids as successful or unsuccessful in accordance with the associated auction format for each lot (col. 11, lines 6-10).

Claims 20, 28, 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Huberman (US 5826244) ("Huberman").

Re claims 20, 28, 37 and 46: Woolston/Fraser/Philips combination does not explicitly teach an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction.

Huberman teaches an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction (col. 10, lines 48-61).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Philips combination to include this feature as taught by Huberman. One would have been motivated to do so in order to allow for flexibility taking into account customer preferences and the nature and characteristics of the item being auctioned.

Claims 21, 29, 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Brown (US 5794219) ("Brown").

Re claims 21, 29, 38 and 47: Woolston/Fraser/ Philips combination does not explicitly teach wherein bid-receiving means receives the bid from a bid form. Brown teaches wherein bid-receiving means receives the bid from a bid form (Figures 5, 6 and 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/

Philips combination to bid forms as taught by Brown. One would have been motivated to do so in order to provide a standard format for which bidder enter their bids.

Claims 25, 34, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Mackinnon, D. J. ("Playing the Auction Game"; SU2 Edition, Toronto Star, Ont.: Oct. 4, 1987. pg E.1) ("Mackinnon").

Re claim 25, 34, 43 and 52: Woolston/Fraser/ Philips combination does not explicitly teach proxy bidding. Mackinnon teaches of proxy bidding (page 3 of 3, paragraph 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Anderson combination to include this feature as taught by Mackinnon. One would have been motivated to do so in order allow participant to set maximum bids without monitoring the auction.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691